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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,088	03/22/2004	Mary R. Flack	225011	1687
45733 7590 05/21/2008 LEYDIG, VOIT & MAYER, LTD. TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731				
EXAMINER ANDERSON, JAMES D				
ART UNIT		PAPER NUMBER		
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05/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARY R. FLACK, RICHARD KNAZEK and MARCUS
REIDENBERG

Reissue Application 10/806,088
Patent 6,114,397
Technology Center 1600

Mailed: May 21, 2008

Before LYNN M. KRYZA, *Deputy Chief Trial Administrator*.

ORDER RETURNING UNDOCKETED APPEAL

This application was electronically received by the Board of Patent Appeals and Interferences on May 02, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner to address the following matter(s) requiring attention prior to docketing:

A review of the record reveals that claims 11, 12, 13, and 14 in the Claim Appendix of the Appeal Brief are not consistent with amended claims 11, 12, 13, and 14 submitted in the amendment filed on February 02, 2006. Specifically, the amendment filed on February 02, 2006, includes changes to claims 11, 12, 13 and 14, appropriately indicated by markings pursuant to 37 C.F.R. § 1.173, as well as the status identifier “once amended” for claims 12, 13 and 14 and “twice amended” for claim 11. However, the subsequent amendments, received on October 20, 2006, February 22, 2007, and May 14, 2007, respectively, as well as the Claim Appendix in the Appeal Brief, continue to include the claim status identifier of “once amended”, for claims 12, 13, and 14, but do not appear to include any amendments to the claims. Regarding claim 11, although the subsequent amendments include the status identifier “twice amended” they do not include the amendatory language for claim 11 when it was twice amended with the amendment of February 2, 2006. It is noted that the remarks accompanying the subsequent amendments do not appear to explain such discrepancies.

In addition, a review of newly added claim 16 shows that there are inconsistencies in the claim status identifier as well as the amendment format. The first amendment, received on March 22, 2004, indicates that claim 16 is a newly added claim; however, the subsequent amendments, as well as the Claim Appendix in the Appeal Brief, indicate the claim as either “pending”, “never amended”, or there is no status identifier. Claim 16 is not completely underlined in every amendment presented. It should be noted that in a reissue application, a “new” claim remains a “new” claim, even though it may be further amended during prosecution, because it is “new” to

the patent, and a new claim should always be completely underlined pursuant to 37 C.F.R. § 1.173, for the same reason.

With regard to the November 27, 2007, communication entitled “Response to Reply Brief” mailed to the appellant, this response contains comments on the substance of the reply brief which goes beyond simply noting the receipt and entry of the reply brief pursuant to 37 C.F.R. § 41.43(a)(1).

Accordingly, it is

ORDERED that the application be returned to the examiner for the following:

1. clarification on the record by appellant as to whether amended claims 11, 12, 13, and 14 submitted in the amendment filed on February 02, 2006, are the claims on appeal, as well as to correct claims 11, 12, 13, 14 and 16 in the Claims Appendix of the Appeal Brief, as appropriate;
2. clarification on the record by the primary examiner as to whether the grounds of rejection of record apply to the amended claims 11, 12, 13, and 14 submitted in the amendment filed on February 02, 2006, or whether the grounds of rejection apply to the appropriate version of the claims on appeal once clarified by appellant;

3. proper treatment of the Reply Brief pursuant to 37 C.F.R.
§ 41.43(a)(1); and
4. for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

LMK/mat

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